

REMARKS

Claims 69-132 are currently pending. The Examiner has required a restriction between the claims of Groups 1-9 as follows:

- Group 1: claims 69, 88-94 and 100; drawn to a method with IL-5 polypeptides;
- Group 2: claims 69-94 and 100, drawn to a method with IL-5 analogue polypeptides;
- Group 3: claims 69, 95-99, 100 and 121-124, drawn to a method with IL-5 polynucleotides;
- Group 4: claims 69, 95-99, 100 and 121-124, drawn to a method with IL-5 analogue polypeptides;
- Group 5: claims 101-102 and 105, drawn to IL-5 analogue polypeptides and compositions containing IL-5 analogue polypeptides;
- Group 6: claims 103 and 105, drawn to a composition containing IL-5 polypeptides;
- Group 7: claims 106-120 and 125-128, drawn to polynucleotides, vectors, host cells and compositions containing claimed polynucleotides encoding IL-5 analogue polypeptides;
- Group 8: claims 129 and 131-132, drawn to a method of identifying IL-5 analogue polypeptides; and
- Group 9: claim 130, drawn to a method of making IL-5 analogue polypeptides.

The Examiner argues that restriction for examination purposes is proper because all of the inventions are unrelated to one another because they are directed to different methods, having different starting materials, different modes of operation, different functions, different effects, different objectives and/or different outcome measures. The Examiner also argues that the inventions are distinct as shown by their different classification, separate search requirement and divergent subject matter. The Examiner has also required the Applicant to make a species election in the event Group 1-3 or 4 is elected. Applicant respectfully traverses both the restriction and species election requirements for the reasons set forth below. Reconsideration and removal thereof is respectfully requested.

Applicants would first point out that the Examiner has erroneously applied U.S. restriction practice standards to the present invention. Since this is the national phase of a PCT application pursuant to 35 U.S.C. §371, the unity standard must apply and the unity of invention must be analyzed under PCT Rule 13. The Examiner will note that no unity of invention objection was raised during the international phase of this application where the unity of invention standard of PCT Rule 13 was applied. Applicant would point out that the claims in at least groups 1, 2, 4, 5, 6, 7 and 9 share a common inventive or linking concept, namely the definition of the IL5 analogue structures. Referring to Examples 1, 4, 15, 16 and 17 in Annex B of the PCT Administrative Instructions, it is clear that examination of these claims within a single application is proper.

An international application which complies with those unity of invention requirements must then be accepted by all of the designated and elected offices, including the USPTO, since Article 27(1) of the Patent Cooperation Treaty does not permit any national law or national office to require compliance with different regulations relating to the contents of the international application. Thus the U.S. application must be examined for Unity of Invention consistent with the Patent Cooperation Treaty, not just by giving verbal assent to the unity of invention standard by mere reference to the PCT Rule, but rather an actual application of the standard. See *Caterpillar Tractor Co. v. Commissioner of Patents and Trademarks*, 231 USPQ 590 (E.D. VA 1986). In this case, proper application of the unity of invention standard means that the application of PCT Rule 13 by the USPTO should be consistent with the application by the PCT Examiner of the same rule for the same subject matter. This means that the Examiner's restriction requirement is improper, in that all of the claims in the application should be searched and examined together.

In view of the foregoing remarks, Applicants submit that all of the claims of Groups 1-9 (i.e. claims 69-132) form a single general inventive concept under PCT Rule 13.1 and should be examiner together in a single application.

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In the event that the Examiner refuses to apply the unity of invention standard, Applicants submits that the examination of all the claims in a single application is justified under U.S. Restriction Standards. This is because there is no serious burden on the Examiner to search and examine the claims. As shown in the Office Action, the searches for each group of claims is coextensive and overlapping. For example, the claims of Groups 1, 2, 5, 6 and 8 are all classified in Class 514, Subclass 2. Groups 3 and 4 are both classified in Class 514, Subclass 44. In view of the substantial identity of classification amongst the Groups, Applicant submits that the Examiner could easily search and examine the pending the claims in a single application. There is no objective evidence that to do so would constitute or pose a serious burden (MPEP 803.01). Applicant request reconsideration and removal of the Restriction Requirement.

However, in order to be fully responsive to the Office Action, if the Examiner maintains the full scope of the restriction requirement, then Applicants provisionally elect to prosecute the claims of Group 2, i.e. claims 69-94 and 100 drawn to a method with IL-5 analogue polypeptides.

Since Applicant has elected Group 2 for search and examination on the merits, the Examiner has further required a species election from each of group I-VII on pages 8-17 of the Office Action. Applicant makes the following species election:

- I. Modification of IL-5 B-cell epitope wherein the modification is selected from:
  - a) one foreign T<sub>H</sub> epitope is introduced (singularly).
- II. Foreign T-cell epitope wherein the epitope is selected from: h) natural promiscuous T-cell epitope.
- III. Natural T-cell epitope wherein the epitope is selected from: i) tetanus toxoid epitope.
- IV. A first moiety wherein the moiety is a binding partner selected from: o) APC specific antigen.
- V. A second moiety wherein the second moiety is selected from: p) a cytokine.
- VI. Cytokines: aa) GM-CSF.
- VII. Heat-Shock Proteins: ff) CRT.
- VIII. A third moiety wherein the moiety is a lipid group selected from: gg) palmitoyl.

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Applicant has added claims 133-141 which correspond to the species elections referenced above. No new matter has been added.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned below at 714-708-8555 in Costa Mesa, CA to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), the Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application and the required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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